

REMARKS

Claims 1-11 are pending in the application. By this Amendment, claim 1 is amended. Applicants respectfully request reconsideration in view of the above amendments and following remarks.

Entry of the amendments/remarks is proper under 37 C.F.R. §1.116 since the amendments: (a) place the application in condition for allowance (for the reasons discussed herein); (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout the prosecution); (c) satisfy a requirement of form asserted in the previous Office Action; (d) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (e) place the application in better form for appeal should an appeal be necessary. The amendments are necessary and were not earlier presented because they are made in response to arguments raised in the Final Rejection. Entry of the amendments is thus respectfully requested.

The Office Action rejects claims 1-11 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 4,642,247 to Mouri et al. (hereinafter “Mouri”) in view of U.S. Patent No. 6,419,356 (hereinafter “Sadasivan”) to Sadasivan et al. The rejection is respectfully traversed.

In order to establish a prima facie case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the combined references themselves or in the knowledge generally available to one of ordinary

skill in the art, to combine reference teachings. Second, there must be some expectation of success. Third, the cited references must disclose or suggest all of the claim limitations. MPEP 2143. Applicants maintain that the Office Action fails to establish a prima facie case of obviousness with respect to claims 1-11.

Mouri describes a recording medium having an upper layer and an under layer that is more hydrophilic than the upper layer. Sadasivan describes an ink-receiving layer containing a surfactant having an HLB number of less than about 10.

The references, alone or in combination, do not disclose or suggest all of the claimed features. Claim 1 discloses "the ink-permeable layer comprising a surfactant having an HLB value of 9 or less." Neither Mouri nor Sadasivan discloses or suggests the ink-permeable layer having an HLB value of 9 or less. Sadasivan describes HLB values as applied to the ink-receiving layer, not the ink-permeable layer. As is apparent, the HLB value of the ink-permeable layer has a different effect than that of the ink-receiving layer. The ink-permeable layer must allow the transfer of ink through its layer in a uniform manner. In contrast, the ink-receiving layer must receive and hold the ink so that the image appears smooth and consistent. Thus, it is respectfully submitted that the ink-permeable layer teaching of Sadasivan neither teaches nor suggests the ink-receiving layer HLB of the present invention.

In addition, neither Mouri nor Sadasivan disclose or suggest an ink-receiving layer having an inorganic filler having at least one hydrophilic group laid bare on a surface of the inorganic filler and the surface of the filler is covered with at least one

lipophilic group of surfactants, as recited in claim 1. Thus, the applied references fail to disclose the features of claim 1 as described above.

Further, the Office Action does not provide the requisite motivation for combining Mouri and Sadavisan. Sadavisan does not discuss an upper layer, or ink-permeable layer, that is less hydrophilic than an under layer. The surfactant of Sadavisan correlates to the ink-receiving layer. Thus, Mouri and Sadavisan fail to provide the requisite suggestion for combining and/or modifying their teachings to arrive at the claimed invention. Applicants maintain that the Office Action does not provide any evidence of a motivation to add a surfactant to the upper layer of Mouri having an HLB of 9 or less. Thus, Applicants maintain that claims 1-11 are not rendered obvious by the cited references. Therefore, withdrawal of the rejection of claims 1-11 under 35 U.S.C. § 103 is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request the reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-1349. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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